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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,612	01/11/2001	Jonathan M. Polk	Polk 1	8997

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EXAMINER

FRIDIE JR, WILLMON

ART UNIT	PAPER NUMBER
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3722

DATE MAILED: 01/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/758,612

Applicant(s)

Polk

Examiner

Willmon Fridie

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Oct 17, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15-17, 24, 26, 30-38, and 40-44 is/are rejected.
- 7) ☒ Claim(s) 14, 18-23, 25, 27-29, and 39 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,2,5,6,10,30,31,33 and 42-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Hara.

3. Hara discloses all of the subject matter as set forth in the claims and is substantially identical to the invention as broadly recited. Hara further discloses distinct, descriptive matter media holding spaces (7L,7S) in 1 to 1 association with the holding device.

4. Claims 11,12,21, 24, 36-38 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang.

Chang discloses all of the subject matter as set forth in the claims and is substantially identical to the invention as broadly recited. Chang discloses a first layer comprising a backing sheet, second layers (1,2,3), (7,9) and a holder arrangement/cut out (8)

5. Claims 40 is rejected under 35 U.S.C. 102(b) as being anticipated by Rosinski, III.

Rosinski, III discloses all of the subject matter as set forth in the claims and is substantially identical to the invention as broadly recited.

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6. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Bergh et al..

Bergh et al discloses all of the subject matter as set forth in the claims and is substantially identical to the invention as broadly recited.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 34 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Zimmerman et al..

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Zimmerman et al. discloses all of the subject matter as set forth in the claims and is substantially identical to the invention as broadly recited.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
11. Claims 3,4,7-9 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara.

In regard to claims 3 and 7-9, it would have been an obvious matter of design choice to make the different portions of the assembly of whatever form or shape was desired or expedient.

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A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

In regard to claim 4, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a plurality of elements., since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V Bemis Co.*, 193USPQ8.

In regard to claim 32, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the claimed indicia since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of indicia does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

12. Claims 13,15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang.

In regard to claims 13,15 and 16, it would have been an obvious matter of design choice to make the different portions of the assembly of whatever form or shape was desired or expedient.

Art Unit:

A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Allowable Subject Matter

13. Claims 14,18-23,25 and 27-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

14. Applicant's arguments filed 10/17/02 have been fully considered but they are not persuasive. .

In regards to applicant's arguments that Hara fails to disclose a holder arrangement formed in the page; that is also attached along more than one direction and creates a plurality of media holding spaces; the examiner submits that Hara constitutes a three dimensional assembly, hence the holder is formed in the page. The holder is shown having dimensions both in the x and y planes which constitutes more than one direction. Further, it is clear from figure 5, that there are a plurality of media holding spaces (7L,7S). Hence Hara anticipates the claims as broadly presented. Further, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

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limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

a shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

In order to reduce pendency and avoid potential delays, Group 3700 is encouraging FAXing of responses to Office actions directly into the Group...***Official- (703)872-9302...After Final-(703) 872 9303***. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3700 will be promptly forward to the examiner.

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Any inquiries concerning issues other than the substantive content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Representative, Tech Center 3700, (703) 306-5648.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center receptionist whose telephone number is (703) 308-1148.

Conclusion

In order to reduce pendency and avoid potential delays, Group 3700 is encouraging FAXing of responses to Office actions directly into the Group...***Official- (703)872-9302...After Final-(703) 872 9303***. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3700 will be promptly forward to the examiner.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center receptionist whose telephone number is (703) 308-1148.

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16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to W. Fridie, Jr. whose telephone number is (703) 308-1866.



**WILLMON FRIDIE, JR.
PRIMARY EXAMINER**

wf

January 13, 2003

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to W. Fridie, jr. whose telephone number is (703) 308-1866.